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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,887

02/04/2004

Charles H. Perrone JR.

ZIM0587

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43963

7590

03/18/2008

ZIMMER TECHNOLOGY - BAKER & DANIELS
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FORT WAYNE, IN 46802

EXAMINER

SCHILLINGER, ANN M

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/771,887	Applicant(s) PERRONE ET AL.	
	Examiner ANN SCHILLINGER	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,10-16,18,19,21,22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,10-16,18,19,21,22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/18/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 7, 10-13, 15, 16, 18, 19, 21, 22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. (US Pat. No. 6,306,172) in view of Keller (US Pub. No. 2004/0186584). O'Neil discloses the following of claims 1, 15, 16: a tibia base plate (78) comprising an upper surface, a lower surface and an outer perimeter side surface (see Figures 5-6A) extending between said upper surface and said lower surface of said tibia base plate; an insert (66) comprising an upper surface (67), a lower surface and an outer perimeter side surface extending between said upper surface and said lower surface of said insert (see Figures 5-6A); and a configuration that allows rotation and a pin that when inserted prevents rotation (col. 5, lines 21-35). However, regarding claims 1, 7, 10, 15, 21, 24, O'Neil does not disclose the pin being located in outer perimeter side surface. Keller discloses a pin in this location in paragraph 0007 and claim 6 for the purpose of allowing easier instrument accessibility to the pin's location. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the pin in the outer perimeter side surface in order to allow an instrument to more easily access the pin.

O'Neil et al. discloses claims 2 and 18 in col. 1, lines 16-21.

O'Neil et al. discloses claims 3 and 19 in col. 1, lines 31-34.

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O'Neil et al. discloses claims 6 and 22 in col. 5, lines 30-35.

O'Neil et al. discloses claims 11 and 25 as shown in Figure 5-6A.

O'Neil et al. discloses claims 12 and 26 in element 74.

O'Neil et al. discloses claims 13 and 27 in element 72.

Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. in view of Keller, further in view of Hurlburt (US Pat. No. 5,658,344). O'Neil et al., as modified by Keller, disclose the invention substantially as claimed, however, they do not disclose a pin made of metal. Hurlburt teaches a tibial insert with a pin made of metal in col. 6, lines 27-39 for the purpose of utilizing the material's strength. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pin of metal in order to utilize the material's strength.

Response to Arguments

Applicant's arguments filed 1/18/2008 have been fully considered but they are not persuasive. Regarding independent claims 1 and 15, the insert cited above and in the previous Office Action has been interpreted as element 66 of the O'Neil et al. reference. Column 5, lines 10-20 indicate that element 66 is used to form both the rotatable and the non-rotatable configurations presented by O'Neil et al. The claim language requires "a first configuration, wherein said insert is translationally fixed to said base plate and rotatable relative to said base plate." In these independent claims, only the removable pin is used to describe how this configuration may be carried out. The claims do not describe a "second configuration" and how such a configuration may be achieved. In addition, the claim language "comprising" is synonymous with "including," "containing," or "characterized by." It is inclusive or open-ended and does not exclude

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additional, unrecited elements, thus meaning that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.

Conclusion

This is a Request for Continued Examination of applicant's earlier Application No. 10/771,887. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ann Schillinger/
Examiner, Art Unit 3774

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738